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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,874	02/22/2002	Brian Robert Walker	674543-2001.3	2506

20999 7590 03/09/2004

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

GUCKER, STEPHEN

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/080,874

Applicant(s)

WALKER ET AL.

Examiner

Stephen Gucker

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/029,535.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

### DETAILED ACTION

1. The preliminary amendment filed 2/22/02 was not entered because it was not signed by attorney Thomas J. Kowalski. However, in order to expedite prosecution of the instant Application in lieu of an upcoming Applicant-initiated interview, the Examiner is extending a courtesy to Applicant by treating this preliminary amendment as though it had been entered into the instant Application before this First Action on the Merits. Therefore, Applicant is requested to re-submit a signed copy of the preliminary amendment in its entirety, or incorporate all of the changes of the preliminary amendment into the next amendment prepared as part of the response to this Office Action.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: new claim 14 lacks literal support from the specification. It is suggested that Applicant amend the language of claim 14 verbatim into the body of the specification in order to create the necessary support for claim 14.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Lakshmi et al. ("Lakshmi"). Lakshmi teaches measuring the reductase activity of 11-Beta HSD1 (called 11-OR activities in the reference) from brain micropunches. Lakshmi discloses that NADPH increased the specific reductase activity by 4-fold (pages 1743-1744), meeting the broad limitations of the claim of determining whether a compound or composition is a regulator of intracellular glucocorticoid activity.

5. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Gomez-Sanchez et al. ("Gomez-Sanchez "). Gomez-Sanchez teaches the administration of carbenoxolone (an inhibitor of 11-Beta HSD1 reductase activity, see abstract of Gomez-Sanchez) to rat brain via intracerebroventricular (i.c.v.) infusion (page E1126). Gomez-Sanchez meets the broad limitations of the claim because Gomez-Sanchez measures the blood pressure of the rat receiving the inhibitor of 11-Beta HSD1 reductase activity as a determinant as to whether or not the compound or composition is a regulator of glucocorticoid activity (abstract and Figures 1-3).

6. No claim is allowed.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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Art Unit: 1647

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supervisor, Gary Kunz, can be reached at (571) 272-0887. The fax phone number for this Group is currently (703) 872-9306.

SG

Stephen Gucker

March 8, 2004

*Gary D. Kunz*  
GARY KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600